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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,914	03/06/2002	Yasuteru Takahama	02138/LH	9197
1933	7590	05/13/2004	EXAMINER	
FRISHAUF, HOLTZ, GOODMAN & CHICK, PC			NGUYEN, THONG Q	
767 THIRD AVENUE			ART UNIT	
25TH FLOOR			PAPER NUMBER	
NEW YORK, NY 10017-2023			2872	

DATE MAILED: 05/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/091,914

Applicant(s)

TAKAHAMA, YASUTERU

Examiner

Thong Q Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7, 10 and 13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7, 10 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/20/2004
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. The present Office action is made in response to the amendment filed on 2/20/2004. It is noted that in the mentioned amendment, applicant has amended the specification and the claims. Regarding to the claims, applicant has amended claims 1-4, 7, 10 and 13 and canceled claims 5-6, 8-9, 11-12 and 14-15. As a result, the pending claims 1-4, 7, 10 and 13 are examined in this Office action.

### ***Specification***

2. The lengthy specification which is amended by the amendment of 2/20/2004 has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 is indefinite because the feature "the optical element" (line 2) lacks a proper antecedent basis. Applicant should note that the base claims 1 and 2 have not provided a proper antecedent basis for the mentioned feature. It is also noted that the mentioned rejection to the claim was made in the previous Office

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action (see Paper No. 6, page 3, element 7©); however, applicant has not made any amendment(s)/argument(s) to overcome the rejection.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uchida et al in view of Meyer et al (both of record).

Uchida et al disclose a microscope having an illuminating system. The microscope as described in columns 2 and 4-7 and shown in figures 1-4 comprises a main housing (10) supporting a stage (21) whose height with respect to the base (10) is variable; a revolver (71) supporting a plurality of objective lens; a focusing mechanism for adjusting the space between the revolver and the sample supported by the stage for the purpose of adjusting the focus; a set of optical elements including lens elements for forming an intermediate image of the sample. The illuminating system comprises a light source and optics for guiding light to illuminate the sample wherein the illuminating system is able to remove from the main body of the microscope. The microscope also comprises an additional system attached to the main body of the microscope wherein the additional system comprises an observation tube supporting a plurality of optical elements which includes at least one lens

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element (42) which is in combination with the lens element (13) located inside the base of the microscope for forming a relay lens system.

Regarding to the feature related to the microscope main body having two portions into which at least two additional units are insertable as recited in the newly-added material to the claim 1, it is noted that such a structure is disclosed by Uchida et al as can be seen in the description provided in column 6, lines 32-46 and shown in figure 3. In particular, Uchida et al disclose that the main body of the microscope comprises space between the revolver supporting plural objectives and image forming optics wherein two additional units, i.e., an illuminating system for fluorescent illumination and a laser manipulation device.

As a result, the only feature missing from the art of Uchida et al is that it does not explicitly state that the additional system is removably attached to the main body of the microscope wherein the system comprises an optical element for splitting a part of the light beam to an image pickup device.

However, the use of an observation system having at least one lens of a relay lens system and a splitting element for splitting a part of light to an image pickup device wherein the observation system is able to removable attach to the main body of a microscope is known to one skilled in the art as can be seen in the microscope provided by Meyer et al. See columns 4-5 and figs. 1-2 and 6-7, for instance. Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the microscope provided by Uchida et al by using an observation system having at least one tube for supporting a part of

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relay lens system and a splitting element as suggested by Meyer et al for the purpose of providing a means for guiding the image of a sample to a pickup device.

7. Claims 7, 10 and 13, as best as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Uchida et al in view of Meyer et al as applied to claims 1-2 above, and further in view of Meyer et al (U.S. Patent No. 4,210,384).

The combined product provided by Uchida et al and Meyer et al as described above does not disclose the use of an optical element in the form of a reflecting element which is selected from a rotated reflecting element for varying the angle of the light reflected therefor as recited in present claim 10 or a combination of a reflecting element for reflecting light from the objective lens system in a horizontal direction and a reflecting element for reflecting light from the objective lens in an upward or oblique direction as claimed in pending claims 7 and 13.

However, the use of a rotating reflecting element or a reflecting element from a combination of two mirrors as recited in the present claims is merely that of a preferred embodiment and no criticality has been disclosed. The support for that conclusion is found in the manner in which the additional unit is attached to the main body of the microscope. In other words, if the additional unit is attached to the main body of the microscope to receive light in a horizontal direction then the optical element is arranged to direct its reflected light in a horizontal direction and if the additional unit is attached to the main body of the microscope to receive light in an upward/oblique direction then the optical element is arranged to direct

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its reflected light in an upward/oblique direction. In such an opinion then the use of a rotating optical element for changing the direction of light reflected therefor is disclosed in the art as can be seen in the microscope provided by Meyer et al '384. For instance, in column 3 and figs. 3 and 4, Meyer et al suggest the use of a mechanism having mirror and a knob for rotating the orientation of the mirror for the purpose of changing the light direction reflected therefor to different locations in which different receivers are located. Regarding to the use of a mirror selected from a combination of two mirrors in which one is used for reflecting light in a horizontal direction and the other one is used for reflecting light in an oblique direction, such use is considered as an obvious matter within the level of one skilled in the art based on the space and the manufacture cost when the function of use a rotating mirror or a mirror selected from the combination is the same. Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the combined product provided by Uchida et al and Meyer et al by using a rotating mirror as suggested by Meyer et al '384 or using a mirror selected from a combination having one is used for reflecting light in a horizontal direction and the other one is used for reflecting light in an oblique direction for the purpose of changing the direction of light from an objective to different receivers located in different locations.

### ***Response to Arguments***

8. Applicant's amendments and arguments as provided in the amendment filed on 2/20/2004 has been entered and has resulted as follow:

A) The amendments to the claims 1-4, 7, 10 and 13 are sufficient to overcome the rejection of claims under 35 USC 112, second paragraph except the claim 10 which claim is still subjected to a rejection under 35 USC 112, second paragraph for the reason set forth in this Office action.

B) The cancellation of claims 5-6, 8, 11 and 14 are sufficient to over come the objections of the claims under 37 CFR 1.75.

C) Regarding to the rejection of the claims under 35 USC 103(a) over the art of record, it is noted that the amendments to the claims and applicant's arguments with respect to pending claims 1-4, 7, 10 and 13 have been considered but are moot in view of the new ground(s) of rejection.

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### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any



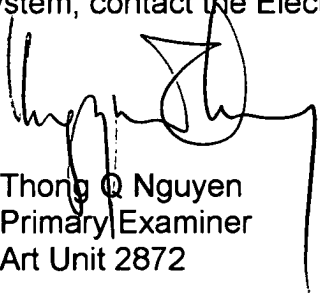
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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q Nguyen whose telephone number is (571) 272-2316. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thong Q Nguyen  
Primary Examiner  
Art Unit 2872

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